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No. 505

IN THE

Supreme Court of the United States

October Term 1963

COMMITTEE APPOINTED BY THE COURT OF COMMON PLEAS OF FRANKLIN COUNTY, OHIO,
Petitioner,

vs.

BATTELLE MEMORIAL INSTITUTE,
Respondent.

BRIEF ON BEHALF OF RESPONDENT

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STATEMENT OF THE CASE

Petitioner's Statement of the Case is substantially correct as far as it goes.

Opinions given by members of the legal department of Respondent including the patent section are given only to Respondent—not to others. This includes opinions as to patentability and infringement.

The trial court made no finding that Respondent's legal department drafted contracts or gave legal advice with respect to *issued patents*.

The Ohio Court of Appeals disposed of the case, by dismissal, on *procedural grounds* which involved no affirmation or negation of the allegations in Petitioner's application.

The alternative remedies pointed out by the Ohio Court of Appeals are not *obiter dicta*, since they explain its action in dismissing the Petitioner's application. But even if it could be said to be *obiter dicta* it is a judicial recognition of available alternative remedies.

The Respondent is a charitable corporation not for profit incorporated under the laws of Ohio, for, and carrying on research work in the field of science. It is one of the largest research organizations in the world. Its research is carried on both in this country and in Europe. About half of such research is for the federal government, and much of this is highly secret. Its patent agents and attorneys are indispensable to the research men in enabling them to chart the course of their research. The patent practice here in question is obviously only a small part of Respondent's overall operation.

The members of Respondent's legal department including the patent section do not participate in any court proceedings or litigation.

ARGUMENT

There is no constitutional question; no federal question; and no question of great public interest here that was not considered and decided in *Sperry v. State of Florida ex rel The Florida Bar*; 373 US 379, 10 L ed 2d 428.

Seasonably after the judgment entered by the Ohio Court of Appeals the Petitioner appealed as of right to the Supreme Court of Ohio urging a constitutional question and contemporaneously therewith filed a motion to certify the record on the ground that the case was one of public or great general interest.

The appeal was denied on the ground that no debatable constitutional question was involved.

The motion to certify the record was overruled without comment. This was a determination that the case was not one of public or great general interest. In reaching this result the Supreme Court of Ohio, of course, had before it the decision of the Ohio Court of Appeals.

That there is no debatable constitutional question here cannot seriously be questioned. It is not claimed that Respondent is immune from state control in respect to activities which are recognized as the practice of law. Accordingly there is no question under the Tenth Amendment. This Court in the *Sperry* case so held, saying "we have not overlooked respondent's constitutional arguments, but we find them singularly without merit."

Nor is there a federal question of substance involved here. The Ohio Court of Appeals decided that Petitioner had chosen the wrong remedy and also that it was not a proper party. This clearly is a non-federal question. Moreover, that court declined to decide that Respondent was engaged in the unauthorized practice of law although it could have considered that question if it had not chosen to place its decision on procedural grounds. Here the Ohio Court of Appeals, reviewing the record before it, set aside the judgment of the trial court which had found that Respondent was engaged in the unauthorized practice of law and dismissed Petitioner's Application. Its judgment, based upon *adequate and independent state grounds*, was not disturbed by the Supreme Court of Ohio. Neither party questions that the regulation of the practice of law belongs to the judicial branch of government and not to the legisla-

tive branch or that the court of final jurisdiction in Ohio is the highest authority of the judicial branch.

And even if it could be said that the decision of the Ohio Court of Appeals might be rested in part on a federal ground i. e. the federal supremacy doctrine, this would not rule out the possibility or even probability that the decision was rested on a nonfederal ground. In this situation it is well settled that this Court will not review. *Stembridge v. Georgia*, 343 US 541, 547, 96 L ed 1130, 72 S Ct 834 (1952), *Darley v. Mayo*, 351 US 277, 76 S Ct 806, 100 L ed 1178 (1956), *Murdock v. Memphis*, 87 US 590, 22 L ed 429 (1874), *Berea College v. Kentucky*, 211 US 45, 29 S Ct 33, 53 L ed 81, (1908), *Fox Film Corp. v. Muller* 296 US 207, 56 S Ct 183, 80 L ed 158 (1935). Jurisdiction cannot be founded on surmise. *Lynch v. New York ex rel Pierson*, 293 US 52, 55 S Ct 16, 79 L ed 191 (1934)

It is quite clear from the *Sperry* decision that a state maintains control over the practice of law within its borders except to the limited extent necessary for the accomplishment of federal objectives. Ohio, in the exercise of its control, has determined that practice before an administrative body or agency is not the practice of law. *Goodman et al v. Beall, et al.*, 130 Ohio State 427, 200 NE 470 (1936) and *Public Service Traffic Bureau v. Haworth Marble Co.* 40 O App 374, 178 NE 703 (1931). Specific reference was made therein to patent practice. While in the *Sperry* case this Court recognized that under the law of Florida patent practice is the practice of law, this is not so in Ohio. Thus it is clear that even if this case were to be reversed and

remanded, the judgment would be the same. It is clear that in this situation this Court will not review the judgment here. In *Herb v. Pitcairn*, 324 US 117, 65 S Ct 459, 89 L ed 789 this Court said at page 794 of 89 L ed:

> "Our only power over state judgments is to correct them to the extent that they incorrectly adjudge federal rights. And our power is to correct wrong judgments, not to revise opinions. We are not permitted to render an advisory opinion, and if the same judgment would be rendered by the state court after we corrected its views of Federal laws, our review could amount to nothing more than an advisory opinion."

Petitioner's First Question

As to Petitioner's first question (p. 9 of its brief) it seems clear that if the Commissioner of Patents wishes to object to Respondent's status in the circumstances here he obviously has the power to do so. Nothing that the Ohio courts have done or could do can limit or affect such power. And, Ohio cannot interfere in his regulation of patent practice. Nor is the Petitioner, as representative of the Ohio Bar, a party in interest to question Respondent's relationship, if any, to patent practice. Its interest is, of course, limited to the practice of law in Ohio. On this subject the Ohio courts have spoken as noted above. There is nothing in the *Sperry* case to the contrary.

Petitioner's Second Question

In respect to Petitioner's second question it should be pointed out again that the Supreme Court of Ohio did not review this case on the record and therefore did not hold what Petitioner attributes to it on Page 10 of its brief. If this was accidental and Petitioner meant the Ohio Court of Appeals, it is clear that that court did not hold, even by inference, that Respondent was practicing law. Indeed, it declined to do so by recognizing in effect that there was

no practice of law here on the part of Respondent and by finding that this action was not a proper one brought by proper parties. What has been said above concerning Petitioner's first question applies also to the second question.

Petitioner's Third Question

The third question of Petitioner involves an irrelevant, if not impossible assumption, as a premise, and then requests this Court to give an advisory opinion based upon that premise. In the situation here the question of what particular acts Respondent can be charged with as constituting the unauthorized practice of law under Ohio law is irrelevant. Ohio has held that this kind of practice is not the practice of law. And in any event this Court, of course, will not give advisory opinions. *Herb v. Pitcairn*, supra.

As stated above, there was no evidence below that Respondent's patent men drafted legal documents for or gave legal opinions to anyone except to Respondent, their employer. Specifically, there was no evidence that any such documents were so drafted or legal advice given to Respondent's sponsors of research projects. However, as to the giving of legal advice in respect to patent matters this Court said, in a footnote to its decision in the Sperry case, ". . . a practitioner authorized to prepare patent applications must of course render opinions as to the patentability of the inventions brought to him, —". Beyond this the Court would no go, but remanded the case to the Florida Supreme Court for further proceedings not inconsistent with its opinion.

Petitioner is in error in stating the Supreme Court of Ohio has construed the *Sperry* case as holding that federal jurisdiction is applicable to all legal services which relate to patent matters. It did not review the case—it merely dismissed the appeal and refused to certify the record.

There is no conflict here between federal power and state power in the field of regulation of the practice of law. While the existence of the federal power and the Ohio rule on the practice of law doubtless resolve the issue, we think it appropriate to point out that nothing in the decision of the Ohio Court of Appeals will impair state regulation of the practice. It will be no serious obstacle in carrying out the *modus vivendi* which recognizes the legitimate interests of both sovereigns.

For the reasons stated, it is respectfully submitted that the petition should not be granted.

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